REMARKS

Claims 1-69 are pending in the present application. Claims 1-69 have been amended. No new matter has been added as a result of the amendments to the claims. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 102(e), Alleged Anticipation, Claims 1-69

The Office Action rejects claims 1-69 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication 2002/0116336 published by Diacakis. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re bond*, 910 F .2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Specifically, Diacakis does not teach every element of the claimed invention arranged as they are in claims 1, 24 and 47 of the present invention.

Amended independent claim 1, which is representative of amended claims 24 and 47 with regard to similarly recited subject matter, now recites:

> 1.   A method in a computer system for providing both directory information and dynamically updated contact information for at least one of a plurality of entities in response to a directory search, said method comprising:
>
>   receiving a query criteria from a user to perform a directory search, said query criteria comprising information that is included in a directory database;
>
>   executing a search of said directory database that comprises static information and does not comprise dynamically updated contact information utilizing said query criteria to produce a first result, said static information comprising a list of names and addresses of potential recipients;
>
>   determining if the first result is a null set;

if the first result is not a null set, invoking a dynamic contact information service utilizing said first result to search an electronic calendaring system to produce a second result containing dynamic contact information about each recipient included in said first result, said dynamic contact information being dynamically updated to indicate a recipient's current contact information and current availability that describe how the recipient can be currently contacted;

if the first result is a null set, determining if the query criteria is valid for submission to the dynamic contact information service;

if the query criteria is valid for submission to the dynamic contact information service, invoking the dynamic contact information service to search the electronic calendar system to produce a second result containing dynamic contact information about each recipient for the query criteria;

coalescing said first and second results to produce a coalesced result;

sorting the coalesced result based on sort preferences received from the user;

filtering the coalesced result based on filter preferences received from the user; and

displaying said coalesced result after sorting and filtering to the user based on display preferences specified by the user. (Emphasis added).

Diacakis does not teach the features emphasized above in amended claim 1. As discussed in the Abstract, Diacakis teaches a method of displaying contact information of individuals for a subscriber of the contact information. For each individual, one or more addresses of the individual for each communication network are received for which the individual is available to the subscriber. Diacakis' method includes generating a single summary indicator for each individual that identifies the individual and summarizes whether the individual is capable of receiving certain data content types, whether the individual is available on certain network types or device types, and/or whether certain groups of people are available. In addition, the method includes displaying the single summary indicator for each individual to the subscriber.

However, Diacakis does not teach executing a search of said directory database that comprises static information and does not comprise dynamically updated contact information utilizing said query criteria to produce a first result. In paragraph 29, Diacakis teaches a system that employs a publisher-subscriber model. When an individual transmits a change in the profile to a server, the server publishes the change to

each of the connected clients that are subscribers of the individual's information. Thus, instead of executing a search of a directory database to produce a result, the subscribers automatically receive the changes from the server when the individual makes a change in the profile. Therefore, Diacakis does not teach executing a search of said directory database that comprises static information and does not comprise dynamically updated contact information utilizing said query criteria to produce a first result.

In addition, Diacakis does not teach determining if the first result is a null set. Since Diacakis does not produce a first result by executing a search of the directory database, Diacakis would not teach determining if the first result is a null set. Nowhere in the reference does Diacakis determine if the first result is a null set. To the contrary, in Figure 5 and paragraph 50, Diacakis only determines a user's availability for each access level based on the user's profile before distributing the availability to the subscribers of the information. Diacakis does not determine if the user's availability is null before distributing the availability. Therefore, Diacakis also does not teach determining if the first result is a null set.

Also, Diacakis does not teach if the first result is not a null set, invoking a dynamic contact information service utilizing said first result to search an electronic calendaring system to produce a second result containing dynamic contact information about each recipient included in said first result. As discussed above, instead of performing a search to produce the user's availability, the subscribers of Diacakis' system automatically receive individuals' availabilities upon changes in profiles made by the individuals. Therefore, Diacakis does not produce a first result by executing a search of the directory database. Since Diacakis does not produce a first result by executing a search, Diacakis would not teach invoking a dynamic contact information service utilizing the first result to search an electronic calendar system to produce a second result, since there is no first result to utilize. Furthermore, since Diacakis does not execute a search to produce the first result, Diacakis could not teach a second result that contain dynamic contact information about each recipient included in the first result.

Diacakis' system is different from the presently claimed invention in that Diacakis publishes individuals' availabilities automatically to the subscribers without the subscribers performing a search. The presently claimed invention performs two different

searches after receiving a query criteria from the user: one to produce a first result utilizing the query criteria, another to produce a second result utilizing the first result. Diacakis fails to teach either search. Instead, Diacakis teaches publishing individuals' availabilities when a change is made by the individuals.

Furthermore, Diacakis does not teach if the first result is a null set, determining if the query criteria is valid for submission to the dynamic contact information service. Nowhere in the reference does Diacakis determine if the query criteria received from the user is valid for submission, because Diacakis' subscribers do not have to submit a query criteria for a search. Rather, Diacakis' subscribers automatically receive individuals' availabilities.

Moreover, Diacakis does not teach if the query criteria is valid for submission to the dynamic contact information service, invoking the dynamic contact information service to search the electronic calendar system to produce a second result containing dynamic contact information about each recipient for the query criteria. As discussed above, Diacakis' subscribers do not submit a query criteria for a search. Therefore, Diacakis would not teach producing a second result that contains dynamic contact information about each recipient for the query criteria.

In addition to the above, Diacakis does not teach sorting the coalesced result based on sort preferences received from the user or filtering the coalesced result based on filter preferences received from the user. Nowhere in the reference does Diacakis mention sorting or filtering the coalesced result based on sort and filtering preferences received from the user. While Diacakis teaches an adaptive feedback module that filters individual's information, the adaptive feedback module does not filter the information based on filter preferences received by the user. To the contrary, in paragraphs 52-53, Diacakis teaches that the adaptive feedback module monitors the published availability information and makes adjustments to the presence detection engine or the availability management engine if the information is inaccurate or unusable. For example, if the last three times someone called an individual and the individual did not answer, the adaptive feedback module instructs the presence detection engine to not indicate mobile phone availability. Thus, Diacakis' adaptive feedback module filters the information based on

whether the published information is accurate or usable, instead of filter preferences received by the user.

Another difference between Diacakis' system and the presently claimed invention is that only the individuals who are publishing their information may adjust their profile to filter the information published (paragraph 31), the subscribers who are receiving the information cannot specify filter preferences to filter the individual's information. This is different from the presently claimed invention, in which the user may specify sort and filter preferences, such as a maximum number of names to be displayed and an order of display of names where the first displayed names are for people who are available earlier than the people who are displayed later, to sort and filter the coalesced result.

Furthermore, Diacakis does not teach <u>displaying said coalesced result after sorting and filtering to the user based on display preferences specified by the user</u>. **Figure 8** of Diacakis, where Diacakis teaches a "Contacts Program" is shown below:
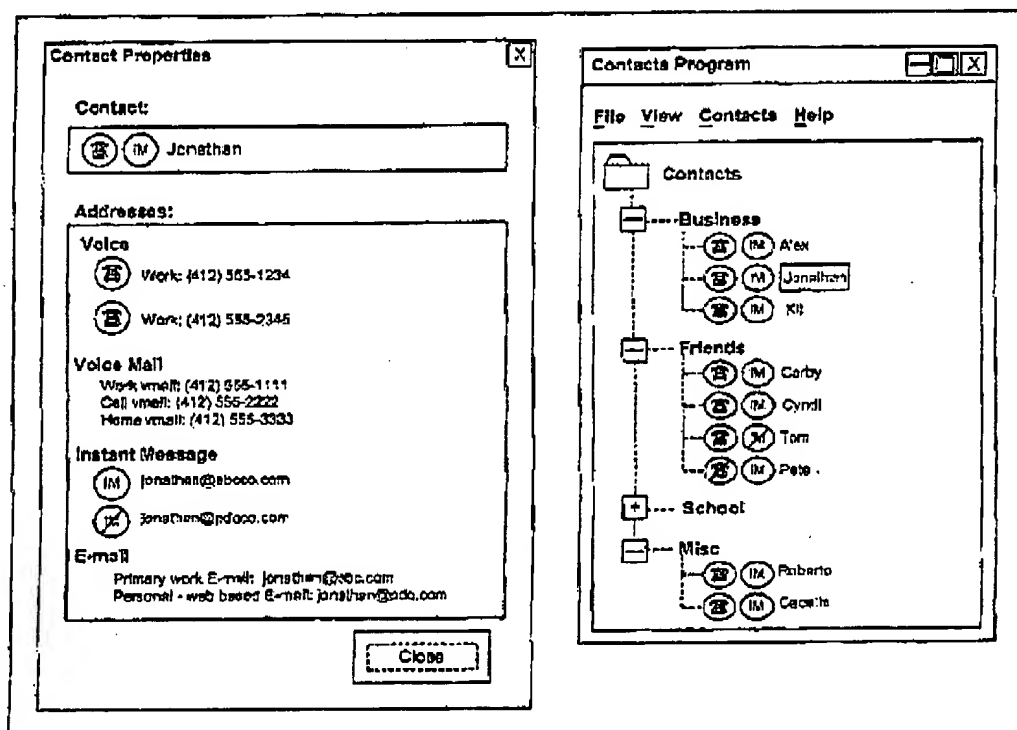

Fig. 8

As shown in **Figure 8**, a merged entry for Alex is displayed indicating that Alex is available on a telephone and IM network. In paragraph 59, Diacakis teaches that the

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single summary indicator in the "Contacts Program" indicates the type of data that individual is available to receive, the device type that the individual is available on, and the availability of a group of people based on whether at least one person of the group is available. Thus, the contact information is displayed in the Contacts Program based on the type of data, the device type, and the availability of a group rather than display preferences that are specified by the user. Nowhere in the reference does Diacakis mention any display preference being specified by the subscribers, let alone displaying the contact information based on display preferences that are specified by the subscribers. Therefore, Diacakis does not teach displaying said coalesced result after sorting and filtering to the user based on display preferences specified by the user.

In view of the above, Diacakis does not teach each and every feature of claims 1, 24, and 47. At least by virtue of their dependency on claims 1, 24, and 47, Diacakis does not teach the features of dependent claims 2-23, 25-46 and 48-68. In addition, dependent claims 2-23, 25-46 and 48-68 of the present invention also contain additional features not found in the Diacakis reference. Accordingly, the rejection of claims 1-69 under 35 U.S.C. § 102(e) has been overcome.

II.   **Conclusion**

It is respectfully urged that the subject application is patentable over Diacakis and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: August 17, 2005

Respectfully submitted,

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